

REMARKS/ARGUMENTS

The Office Action of July 1, 2008, has been carefully reviewed and these remarks are responsive thereto. No new matter has been added. Claims 1-24 are pending upon entry of the present paper. Reconsideration and allowance of the instant application are respectfully requested.

Rejections Under 35 U.S.C. § 101

Claims 8-14 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. This rejection is respectfully traversed.

Amended claims 8-14 are directed to a *tangible* computer-readable medium, and as such, preclude non-statutory subject matter such as a signal and carrier wave.

In view of the amendments, withdrawal of the section 101 rejection is respectfully requested.

Rejections Under 35 U.S.C. § 103

Claims 1-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2006/0010469 to Reynolds et al. ("Reynolds"), in view of U.S. Patent No. 5,812,123 to Rowe et al. ("Rowe"). Applicant respectfully traverses.

Independent claim 1 recites, *inter alia*, "determining that the first broadcasted program is selected for at least a time greater than a predetermined threshold; and responsive to determining that the first broadcasted program is selected for at least a time greater than the predetermined threshold, displaying the selected content in the background area of the interactive programming guide, wherein the selected content is overlapped by information related to the first broadcasted program."

In Applicant's Request For Reconsideration dated March 20, 2008, ("Request For Reconsideration") at pages 7-8, Applicant discussed the reasons why one of ordinary skill in the art would not have had an apparent reason to modify Reynolds to include the disclosures in Rowe. In short, and as discussed, the purpose of Reynolds is to overcome the limitations associated with passive television program guides. See Reynolds at paragraphs [0003]-[0004].

Applicant respectfully submits that in responding to Applicant's remarks, the Office mischaracterized the nature of those remarks, or stated in a slightly different way, did not fully respond to Applicant's remarks. In the Office Action at pages 3-4 ("Response to Arguments"), the Office merely addresses Applicant's argument related to "teaching away." See the Request For Reconsideration at page 8 (citing MPEP § 2141.02 (VI.)).

Even assuming (without admitting) that the above-cited passage in Reynolds (e.g., paragraphs [0003]-[0004]) does not rise to the level of "teaching away," combining Rowe with Reynolds would nonetheless frustrate the intended purpose of Reynolds. See the Request For Reconsideration at page 8 (citing MPEP § 2143.01 (V.)). More specifically, Reynolds at paragraphs [0003]-[0004] describes the frustration a user experiences with respect to passive guides due to being forced to wait until a list of program listings scrolls to display listings for a channel or time that a user is interested in, and that users of passive guides have no way of controlling how quickly or how often listings appear. As such, one of skill in the art would not have had an apparent reason to modify Reynolds with the disclosures of Rowe to obtain features related to determining that a first broadcasted program is selected for at least a time greater than a predetermined threshold, and responsive to determining that the first broadcasted program is selected for at least a time greater than the predetermined threshold, displaying a selected content in a background area of an interactive programming guide as recited in claim 1.

The Office Action at page 4 ("Response to Arguments") and pages 7-8 (in the context of rejecting claim 1) cites *KSR*¹ for the proposition that if all the claimed elements are known in the prior art then one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Applicant submits that the Office has over-simplified the obviousness inquiry under *KSR* in merely providing such a statement. More specifically, while *KSR* rejected a rigid application of the teaching-suggestion-motivation (TSM) test, a flexible TSM test remains to serve as the primary guarantor against non-statutory hindsight analysis, and that the TSM test, flexibly applied, assures that the obviousness test proceeds on the basis of evidence that arises before the time of the invention. See *Ortho-McNeil Pharmaceutical, Inc. v. Mylan Labs. Inc.*, 520 F.3d 1358,

¹ *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, No. 04-1350, slip op. at 12 (2007).

1364-65 (Fed. Cir. 2008). Based on the foregoing remarks regarding the intended purpose of Reynolds, one of skill in the art would not have had a reason to combine Reynolds with Rowe under the flexible TSM test.

Since the combination of references is improper, and neither Reynolds nor Rowe taken in the singular discloses all of the features of claim 1, claim 1 is allowable.

Moreover, with respect to the above-noted features as recited in claim 1, claim 1 requires displaying the selected content in the background area of the interactive programming guide, wherein the selected content is overlapped by information related to the first broadcasted program. In the Request For Reconsideration at page 8, Applicant discussed the failure of the references to disclose such features. Applicant incorporates those same remarks herein by way of reference. The Office Action at page 2 (“Response to Arguments”) appears to acknowledge Applicant’s remarks in this respect, but then proceeds at page 3 to merely discuss what Reynolds and Rowe (allegedly) disclose without relating it to Applicant’s remarks. In fact, the discussion in the Office Action at page 3 with respect to Rowe does not appear to address features related to displaying a selected content in a background area of an interactive programming guide, wherein the selected content is overlapped by information related to a first broadcasted program as discussed in Applicant’s remarks. As such, based on pages 2-3 of the Office Action, Applicant is lead to believe that it was the Office’s intention to (primarily) rely on Reynolds as allegedly disclosing such features. On the other hand, in the context of rejecting claim 1, the Office Action at page 7 appears to (primarily) rely on Rowe at Figures 2-4, 6, and 92 as allegedly disclosing the above-described features.

Notwithstanding whether a combination of Reynolds and Rowe is proper, Applicant maintains that the combination of references fails to teach or suggest features related to displaying a selected content in a background area of an interactive programming guide, wherein the selected content is overlapped by information related to a first broadcasted program as required by claim 1 for at least the reasons provided in the Request For Reconsideration at page 8. In the event that the Office elects to maintain a rejection based on Reynolds and Rowe, Applicant respectfully requests clarification in the next communication with respect to how the references allegedly teach or suggest the above-described features. Moreover, Applicant respectfully requests the Office to address the substance of Applicant’s remarks in the Request

For Reconsideration at page 8, as opposed to merely restating what Reynolds and Rowe allegedly disclose. See MPEP § 707.07(f) (providing that where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it).

Independent claims 8, 15, and 23 recite features similar to those described above with respect to claim 1. Claims 8, 15, and 23 are therefore allowable for at least the same reasons discussed above with respect to claim 1.

Claims 2-7, 9-14, 16-22, and 24, which each depend from at least one of independent claims 1, 8, 15, and 23, are allowable for at least the same reasons as their respective base claims, and further in view of the additional advantageous features recited therein.

CONCLUSION

All rejections having been addressed, Applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. Should the Examiner find that a telephonic or personal interview would expedite passage to issue of the present application, the Examiner is encouraged to contact the undersigned attorney at the telephone number indicated below.

If any additional fees are required or if an overpayment has been made the Commissioner is authorized to charge or credit Deposit Account No. 19-0733. Applicant looks forward to passage to issue of the present application at the earliest convenience of the Office.

Respectfully submitted,

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